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10/528,317	11/14/2005	Dale Vonbehren	60287-USA	4525
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Paul A Fair FMC Corporation 1735 Market Street Philadelphia, PA 19103			SHEIKIL, HUMERA N	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/528,317	Applicant(s) VONBEHREN ET AL.
	Examiner Humera N. Sheikh	Art Unit 1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 20 November 2009.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-3,5,6,8-16 and 18 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-3,5,6,8-16 and 18 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/06)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Status of the Application

Receipt of the Response after Non-Final Office Action, the Amendment and Applicant's Arguments/Remarks, all filed 11/20/09 is acknowledged.

Applicant has overcome the following objection(s) and/or rejection(s) by virtue of the amendment to the claims and/or persuasive remarks: (1) The claim objections for claims 4, 6-7, 9, 10 and 12-17 have been withdrawn (The claim objections for claims 5 and 18 still stand); and (2) The 35 U.S.C. §103(a) rejection of claims 1-18 over Wang (U.S. Pat. No. 6,497,861) in view of GB 1,006,706 has been withdrawn.

Claims 1-3, 5, 6, 8-16 and 18 are pending in this action. Claims 1, 2, 6, 8-10, 12-16 and 18 have been amended. Claims 4, 7 and 17 have been cancelled. Claims 1-3, 5, 6, 8-16 and 18 remain rejected.

* * * * *

Claim Objections

Claims 5 and 18 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only, and/or, cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits. Claims 5 and 18 should be amended to recite "any one of the preceding claims", rather than "any preceding claim". In addition, the term "claim" in claim 5 should be made plural to read as "claims".

* * * * *

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said microcrystalline cellulose" in line 18. There is insufficient antecedent basis for this limitation in the claim. The term should read as "said *coprocessed* microcrystalline cellulose".

* * * * *

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 5, 6, 8-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jose et al. (hereinafter "Jose") (U.S. Pat. No. 6,620,417).

Jose ('417) teaches a pigmented cosmetic composition containing organic oil and silicones, whereby the composition provides a long lasting durable finish on the skin and is comfortable to wear (see col. 1, lines 10-31 and Abstract). The cosmetic composition includes the use of: emulsifiers (25-50%) (col. 5, line 66 - col. 6, line 24); additives to enhance the performance of the composition - such as microcrystalline cellulose (rheology enhancer/control agent) in amounts of 1-50%, the microcrystalline cellulose having a particle size of 0.02 to 100

microns (col. 7, lines 23-54) (this particle size meets that of instant claims 1, 5 & 9); sunscreen agents (organic/inorganic) (1-50%) (col. 7, lines 23-54) (col. 9, lines 15-45); and humectants, emollients, water, etc. (col. 10, lines 22-23). Additional agents disclosed include preservatives, antioxidants and vitamins (col. 9, line 47 – col. 10, line 11). The oils used in the composition are taught to have a viscosity of about 10 to 600,000 centipoise (equivalent to 0.10 Pas to 600 Pas). While the viscosity of the composition is not disclosed, it is the position of the Examiner that it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine suitable viscosity ranges or levels through routine or manipulative experimentation, to obtain the best possible results, as these are variable parameters attainable within the art. Moreover, the viscosity of the individual oils falls within the ranges claimed by Applicant and thus would attribute to a suitable consistency for the cosmetic compositions.

The rundown time of 100 seconds or greater of instant claim 16 is met by the teachings of Jose. Jose teaches that their cosmetic composition provides a long lasting durable finish on the skin and is comfortable to wear and is transfer resistant (col. 1, lines 10-31).

Regarding the amounts/ranges (i.e., water - 55-80%), the Examiner notes that generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955).

With respect to the “method of applying a cosmetic by spraying the composition” of instant claim 18, it is the position of the Examiner that this limitation does not impart

patentability to the claims. It is routine practice within the cosmetic art to have alternative methods of application for cosmetic products, such as by spraying, in order to offer convenience of use and application by the consumer.

The instant invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, given the teachings of Jose. Jose explicitly teaches a pigmented cosmetic composition containing, among other skin additives, emulsifiers, rheology enhancers (i.e., microcrystalline cellulose), sunscreen agents, humectants, emollients, water, preservatives, antioxidants, etc. The prior art teaches a composition as claimed comprising essentially the same ingredients as claimed in cosmetically effective amounts and ranges to provide for a beneficial cosmetic product.

* * * * *

Claims 1-3, 5, 6, 8-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pflücker et al. (hereinafter “Pflücker”) (U.S. Pat. No. 7,264,795).

Pflücker (‘795) teaches a sunscreen composition having UV protection properties and a high sun protection factor (see Abstract); (col. 5, lines 6-7). The sunscreen composition includes: organic sunscreen and inorganic sunscreen agents and presun and aftersun preparations (col. 2, lines 1-3; 64-67); (col. 4, lines 52-62) (col. 7, lines 25-28); emulsifiers (i.e., lecithin) (col. 6, lines 5-16); microcrystalline cellulose (rheology enhancer/control agent) (col. 6, line 65 – col. 7, line 4); moisturizers, surfactants, preservatives, pigments, dyes, thickeners, viscosity increasing agents and the like (col. 8, lines 20-61).

Examples of application forms of the cosmetic include sprays. Sprays can comprise customary propellants (col. 6, lines 35-56). Thus, the “method of applying a cosmetic by

spraying the composition" of instant claim 18 is met by the teachings of the '795 Patent, since the compositions can be conveniently provided in the form of sprays.

It is taught that the performance of a cosmetic formulation according to the SPF is influenced by the distribution of the UV filters on the surface of the skin. Therefore the rheology of the formulation is a key issue to increase the SPF (boost effect) (col. 5, lines 12-16).

Regarding instant claims 6 and 7, the microcrystalline cellulose of the prior art (col. 7, line 2) would also be water-dispersible and co-processed absent a showing of evidence to the contrary.

Suitable amounts/ranges are identified in the Examples at columns 11-20 and the Tables at columns 19-34. Moreover, with regards to the instantly claimed percentages or amounts, the Examiner points out that generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955). It would have been obvious to one of ordinary skill in the art at the time the invention was made to determine suitable ranges, percentages or ratios through routine or manipulative experimentation, to obtain the best possible results, as these are variable parameters attainable within the art. Furthermore, no unexpected or superior results have been observed in the instant amounts/ranges claimed. The prior art clearly teaches a formulation essentially the same as claimed based on the use of the same ingredients, as is claimed by Applicants.

With regards to the instant viscosity levels, suitable levels would be a result-effective parameter, obtained via routine experimentation by one of ordinary skill in the art. The reference clearly teaches use of viscosity modifiers (col. 8, line 59) to yield an effective cosmetic composition.

The instant invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, given the teachings of Pflücker. Pflücker explicitly teaches a sunscreen cosmetic composition containing, among other skin additives, emulsifiers, rheology enhancers (i.e., microcrystalline cellulose), sunscreen agents (organic/inorganic), moisturizers, surfactants, preservatives, pigments, dyes, thickeners, viscosity increasing agents and the like. The prior art teaches a composition as claimed comprising essentially the same ingredients as claimed in cosmetically effective amounts and ranges to provide for a beneficial cosmetic product.

* * * * *

Claims 1-3, 5, 6, 8-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanner et al. (hereinafter “Tanner”) (U.S. Pat. No. 5,935,556) in view of GB 1,006,706 (FMC Corp.) (hereinafter “706 Patent”).

Tanner ('556) teaches sunscreen compositions that include: sunscreen actives (UV absorbers, etc.) and emulsifiers in amounts of about 0.1% - about 10% (col. 2, lines 50-57); (col. 3, lines 42-49); (col. 5, line 57 - col. 6, line 21); skin care actives such as humectants, occlusive agents, moisturizers, tanning agents, thickening agents, preservatives and the like (col. 6, line 43 - col. 7, line 29) and water (from about 20-98%) (col. 5, lines 25-28) (this range reads on and encompasses the “about 55 wt% - about 80 wt%” of instant claim 17).

The emulsions provide a viscosity of from about 1 cps to about 1,000,000 cps (equivalent to 0.001 Pas to 1,000 Pas) (col. 3, lines 50-63). This viscosity reads on the viscosity claimed by Applicant (of 120 Pas or less and 80 Pas or less of instant claims 1 and 15, respectively).

Examples of application forms of the cosmetic include sprays and spray-on-products. Sprays can comprise customary propellants (col. 6, lines 22-43). Thus, the “method of applying a cosmetic by spraying the composition” of instant claim 18 is met by the teachings of the ‘556 Patent, since the compositions can be conveniently provided in the form of sprays. Moreover, it is routine practice within the cosmetic art to have alternative methods of application for cosmetic products, such as by spraying, in order to offer convenience of use and application by the consumer.

The reference recognizes and teaches suitable amounts/ranges as identified in the disclosure. Moreover, generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955).

The instant invention would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, given the teachings of Tanner who explicitly teaches a cosmetic sunscreen composition containing, among other skin additives, emulsifiers, sunscreen agents moisturizers, surfactants, humectants, artificial tanners and the like. The prior art teaches a composition as claimed comprising essentially the same ingredients as claimed in cosmetically effective amounts and ranges to provide for a beneficial cosmetic product.

While Tanner does not explicitly teach rheology enhancers, such as microcrystalline cellulose, the use of microcrystalline cellulose in the cosmetic art is well known to one of ordinary skill in this art. Such skill is evident from the '706 Patent (see below).

The **'706 Patent** (FMC Corp.) teaches a cosmetic composition containing cellulose crystallite aggregates, product obtained by the acid hydrolysis of cellulose. Cosmetic compositions disclosed include sunscreens, depilatories and the like (col. 1, lines 10-42). '706 teaches the crystallite aggregates are one of the purest forms of cellulose and are not likely to cause undesirable dermatological reactions (col. 2, lines 61-67). The cellulose crystallite aggregates have a particle size from below 1 micron to 300 microns (col. 2, lines 67-73). It is taught that by virtue of their unique properties, the crystallite aggregates are capable of improving a wide range of cosmetic products. In particular, the aggregates possess the highly useful property of forming stable homogenous colloidal gels and dispersions when suitably mixed with cosmetic ingredients. Further, the use of the aggregates permits production of stable gels and dispersions without requiring presence of other ingredients (i.e., emulsifiers).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the cellulose crystallite aggregates having a particle size from below 1 micron to 300 microns, as taught by the '706 Patent within the cosmetic compositions of Tanner. One would do so with a reasonable expectation of success because '706 teaches that crystallite aggregates possess unique properties and are capable of improving a wide range of cosmetic products. The aggregates are especially useful in forming stable homogenous colloidal gels and dispersions when suitably mixed with cosmetic ingredients. Further, the use of the aggregates

permits production of stable gels and dispersions without requiring the presence of other ingredients. The expected result would be an improved cosmetic composition that exhibits enhanced tactile and aesthetic properties.

* * * * *

Response to Arguments

Applicant's arguments filed 11/20/09 have been fully considered and were found to be partially persuasive.

▪ **Claim Objections:**

Applicant argued, "At page 2 of the Office Action, the Examiner objected to claims 4-7, 9, 10 and 12-18 as being in improper multiple dependent form. Applicants have amended the claims herein to overcome this issue."

Applicant's arguments were persuasive with respect to claims 4, 6-7, 9, 10 and 12-17. Accordingly, the objection for these claims have been withdrawn. However, the objection for claims 5 and 18 is maintained. See objection discussed above.

Applicant argued, "At page 2 of the Office Action, the Examiner objected to claim 1 because "Pa s" appears incorrect. The foregoing amendment overcomes this objection."

Applicant's argument was persuasive. Accordingly, the objection for claim 1 has been withdrawn.

Applicant argued, "At page 2 of the Office Action, the Examiner objected to claim 4. Claim 4 is cancelled herein. Applicant's argument was persuasive. Accordingly, the objection for claim 4 has been withdrawn based on cancellation of the claim."

▪ **Rejection under 35 U.S.C. §103(a) over Jose (US 6,620,417):**

Applicant argued, “Jose is directed to long lasting color cosmetic compositions containing an organic oil and a specific silicone mixture. The composition may be a lipstick, blush, eye shadow, foundation, concealer or the like (col. 1, lines 57-59). Jose discloses microcrystalline cellulose as particulate material (col. 7), but does not provide any disclosure or suggestion of a rheology control agent in a sprayable composition comprising microcrystalline cellulose coprocessed with the added materials in claim 1. Moreover, there is no disclosure or suggestion in Jose that the composition disclosed therein would be useful as a sprayable composition.”

Applicant's arguments have been considered but were not deemed persuasive. The argument that “Jose discloses microcrystalline cellulose as particulate material (col. 7), but does not disclose or suggest a rheology control agent in a sprayable composition comprising microcrystalline cellulose coprocessed with the added materials in claim 1” was not persuasive because Jose clearly teaches ingredients used to enhance performance of their compositions. In particular, Jose teaches microcrystalline cellulose as particulate material and additionally teaches ingredients such as titanium dioxide and calcium carbonate and *mixtures thereof*, which read on the generic “attriting agents” as claimed. In addition, various starches, such as corn starch and rice starch, which read on the generic “bulking agents” as claimed are also disclosed by Jose. See column 7, lines 23-54. Thus, the reference explicitly teaches microcrystalline cellulose as a suitable performance-enhancing ingredient (i.e., rheology-enhancer) and teaches the oxides, carbonates, starches and mixtures thereof could also be employed. As a result, any mixture of a combination of these ingredients (bulking agents, attriting agents, etc.) would yield a coprocessed product. Moreover, with regards to “coprocessing” of the microcrystalline cellulose, the Examiner notes that the instant claims are drawn to product claims (except for

claim 18) and thus, the particular process by which the product is obtained does not impart patentable weight to the claims. The patentability of the product must be established, *per se* and not the manner by which processing was achieved. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). In any event, Jose vividly recognizes and teaches a cosmetic composition comprising the same elements as that claimed by Applicant. With respect to the limitation of a “sprayable” composition, the Examiner points out that “sprayable” denotes a future-intended use of the composition, which without structural limitation, does not accord patentable weight to the claims. Furthermore, as delineated above, it is routine practice within the cosmetic art to have alternative methods of application for cosmetic products (i.e., by spraying), in order to offer convenience of use and application by the consumer.

- **Rejection under 35 U.S.C. §103(a) over Pflucker (US 7,264,795):**

Applicant argued, “Pflucker is directed to a sunscreen composition that addresses the needs of formulations having high SPF by encapsulating organic sunscreens. Pflucker discloses microcrystalline cellulose as a carrier, but does not provide any disclosure or suggestion of a rheology control agent comprising microcrystalline cellulose coprocessed with the added materials in claim 1. The Examiner appears to argue at page 6 of the Office Action that the microcrystalline cellulose “of the prior art” would also be co-processed, but does not offer a single reference in support of this position. Nothing in Pflucker discloses or suggests the use of the presently claimed coprocessed rheology control agent in a sprayable composition as in the present invention.”

Applicant's arguments have been considered but were not persuasive. Pflucker teaches at column 4, lines 59-62 that their composition includes at least one inorganic sunscreen agent, preferably zinc or titanium dioxide. This ingredient reads on the generic "attriting agents" as claimed. Applicants evidence these ingredients to be suitable coprocessing agents as disclosed in the specification at page 6. Hence, Pflucker does teach a composition that includes microcrystalline cellulose in combination with additional processing agents and thus, meets Applicant's limitations. In addition, ingredients taught by Pflucker which read on the coprocessing agents claimed include soaps, surfactants, sugars, and other ingredients customary for cosmetics (see columns 7-8). With respect to the limitation of a "sprayable" composition, the Examiner points out that "sprayable" denotes a future-intended use of the composition, which without structural limitation, does not accord patentable weight to the claims. Nonetheless, Pflucker teaches cosmetic application in the form of "sprays". The sprays can comprise customary propellants (col. 6, lines 35-56). The "method of applying a cosmetic by spraying the composition" of instant claim 18 is also met by the teachings of the '795 Patent, since the compositions can be conveniently provided in the form of sprays.

▪ **Rejection under 35 U.S.C. §103(a) over Wang (US 6,497,861):**

Applicant argued, "Wang is directed to a gelled cosmetic emulsion comprising an oil phase, an aqueous phase and a gelling system which contains at least one non-siloxane based polyamide in a sufficient amount to gel the emulsion. The emulsions are used in lipstick and mascara products as well as other gel and stick products."

Applicant's arguments have been considered and were held persuasive. Accordingly, this rejection has been withdrawn.

▪ **Rejection under 35 U.S.C. §103(a) over Tanner (US 5,935,556):**

Applicant argued, “Tanner is directed to sunscreen compositions comprising an emulsion having at least one oil phase, at least one aqueous phase comprising a formaldehyde donor preservative and emulsifier. Tanner does not disclose the use of microcrystalline cellulose and turns to ‘706 for this disclosure. However, nothing in Tanner discloses or suggests the use of the a rheology control agent in a sprayable composition comprising microcrystalline cellulose coprocessed with the added materials in claim 1.”

Applicant's arguments have been considered but were not persuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, while Tanner does not disclose inclusion of microcrystalline cellulose, the secondary ‘706 reference remedies this deficiency of Tanner based on the ‘706 teaching of a cosmetic composition containing cellulose crystallite aggregates, which aid in obtaining stability of the product. The ‘706 Patent discloses cosmetic compositions as are presently claimed, such as sunscreens, depilatories and the like (col. 1, lines 10-42). Thus, the secondary reference demonstrates that it is well known to one of ordinary skill in the art to employ cellulose in cosmetic products. With respect to processing agents, note that Tanner initially teaches ingredients which read on the processing agents as claimed. For instance, Tanner teaches that their compositions can include pigments, oils, binders, surfactants, carboxylic acids (which contain monomers derived from

acrylic acid) and the like. See column 6, line 42 – col. 7, line 30. Thus, the reference clearly recognizes and teaches coprocessing agents that read on the added materials of claim 1. With respect to the limitation of a “sprayable” composition, the Examiner points out that “sprayable” denotes a future-intended use of the composition, which without structural limitation, does not accord patentable weight to the claims. Nonetheless, Tanner teaches cosmetic application in the form of “sprays and spray on products”. The sprays can comprise customary propellants (col. 6, lines 22-43). The “method of applying a cosmetic by spraying the composition” of instant claim 18 is also met by the teachings of Tanner, since the compositions can be conveniently provided in the form of sprays.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., storage stability in container, even deposition of mist, no tendency to drip) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Lastly, Applicant argued, “none of the cited art suggests that the claimed invention would strike the appropriate balance and solve the problems associated with such sprayable compositions.”

Applicant's arguments were considered but were not convincing. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re*

Kahn, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). (“One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings.”); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). In this instance, the prior art demonstrates obtaining cosmetic formulations, that comprise a combination of ingredients as are instantly claimed, in effective amounts to yield stable cosmetic compositions. The properties desired by Applicant (stability, etc.) are recognized by the art of record. “When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

* * * * *

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

- No claims are allowed at this time.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (571) 272-0604. The examiner can normally be reached on Monday-Friday during regular business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Wax, can be reached on (571) 272-0623. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Humera N. Sheikh/

Primary Examiner, Art Unit 1615

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February 1, 2010

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